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| 10/073,867 | 02/14/2002 | Hiroaki Shibasaki | 041465-5139 | 6343 |

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| EXAMINER | |
|---|---|
| KLIMACH, PAULA W | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2135 | |

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/073,867 | SHIBASAKI, HIROAKI | |
| | Examiner | Art Unit | |
| | Paula W. Klimach | 2135 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

This office action is in response to amendment filed on 11/10/05. Applicant amended Claims 1, 4, 7, and 10. The amendment filed on 11/10/05 have been entered and made of record. Therefore, presently pending claims are 1-10.

### *Response to Arguments*

Applicant's arguments filed 11/10/05 have been fully considered by the examiner.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al (6,735,699 B1) in view of Van Huben et al (6,327,594 B1).

*In reference to claims 1 and 10,* Sasaki discloses a digital work utilization monitoring method and system for preventing illegal use such as unpermitted copying of digital works a storage for storing therein the delivered digital information (part 16 Fig. 1); and a host-function device for performing host function including management of a duplicate condition of the stored digital information and control of input/output actions for the digital information stored in the

storage in response to further instructions sent through the network from the user device (part 20 Fig. 1).

Sasaki does not expressly disclose checking-in the data inside the user device to the storage.

Van Huben discloses the check-in process for storage of digital information from and to the user device (Fig. 12 B).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the check-in process as in Van Huben in the system of Sasaki. One of ordinary skill in the art would have been motivated to do this because this will provide the management of data therefore preventing duplication of data.

**Claims 2-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of Van Huben and further in view of Stallings.

*In reference for claim 2,* Sasaki discloses receiving a request for outputting a designated piece of the digital information, determining (column 5 lines 23-35), on the basis of the duplicate condition of the designated piece of the digital information, whether or not the designated piece of the digital information allowed to be outputted (column 7 lines 6-30),

Although Sasaki discloses delivering the designated piece of the digital information to the user device through the network (step 7 and step 2 Fig. 1), Sasaki does not disclose only delivering the information when the determination has been made such that the designated piece of the digital information is allowed to be outputted.

William Stallings discloses data access control wherein the user can be identified and then the profile specifies permissible operation and file accesses thereby delivering the

information only when the determination has been made such that the designated piece of digital information is allowed to be outputted (page 527-529)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to only distribute the data when the determination has been made that the piece of information is allowed to be output as in Stallings in the system of Sasaki. One of ordinary skill in the art would have been motivated to do this because this would increase the security of the system by defending against intruders and malicious programs.

*In reference to claim 3,* wherein the storage is provided so as to correspond to authentication information owned by each user who utilizes each user device (column 7 lines 6-16).

**Claims 4 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Sasaki and Van Huben.

*In reference to claims 4 and 7,* Wolfe discloses a system and method for delivering programmed music and targeted advertising messages to Internet based subscribers. Wolfe discloses a database for storing therein the digital information to be delivered to a user (Fig 1. part 30). Wolfe further discloses storage for storing therein a piece of the digital information requested from the user device through the network (column 3 lines 47-61 in combination with column 4 lines 30-38);

Wolfe does not disclose a host function device for performing a host function including management of a duplicate condition of the stored digital information.

Sasaki discloses a host-function device for performing a host function including management of a duplicate condition of the stored digital information and control of input/output actions for the digital information stored in the storage in response to further instructions sent through the network from the user device (part 20 Fig. 1).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to manage creation of duplicates as Sasaki in the system of Wolfe. One of ordinary skill in the art would have been motivated to do this because digital data has made creation of copies easier and therefore a rights management system will ensure that the copyright is respected.

Sasaki and Wolfe do not expressly disclose checking-in the data inside the user device to the storage.

Van Huben discloses the check-in process for storage of digital information from and to the user device (Fig. 12 B).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the check-in process as in Van Huben in the system of Sasaki. One of ordinary skill in the art would have been motivated to do this because this will provide the management of data therefore preventing duplication of data.

**Claims 5-6 and 8-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe in view of Sasaki and Van Huben and further in view of Stallings.

*In reference to claims 5 and 8,* Sasaki discloses receiving a request for outputting a designated piece of the digital information, determining (column 5 lines 23-35), on the basis of

the duplicate condition of the designated piece of the digital information, whether or not the designated piece of the digital information allowed to be outputted (column 7 lines 6-30),

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to manage creation of duplicates as Sasaki in the system of Wolfe. One of ordinary skill in the art would have been motivated to do this because digital data has made creation of copies easier and therefore a rights management system will ensure that the copyright is respected.

Although Sasaki discloses delivering the designated piece of the digital information to the user device through the network (step 7 and step 2 Fig. 1), Sasaki does not disclose only delivering the information when the determination has been made such that the designated piece of the digital information is allowed to be outputted.

William Stallings discloses data access control wherein the user can be identified and then the profile specifies permissible operation and file accesses thereby delivering the information only when the determination has been made such that the designated piece of digital information is allowed to be outputted (page 527-529)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to only distribute the data when the determination has been made that the piece of information is allowed to be output as in Stallings in the system of Sasaki. One of ordinary skill in the art would have been motivated to do this because this would increase the security of the system by defending against intruders and malicious programs.

*In reference to claims 6 and 9* wherein the storage is provided so as to correspond to authentication information owned by each user who utilizes each user device (column 4 lines 30-38).

## *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK
Monday, January 16, 2006

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100